

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI OSHIMA

Appeal No. 2002-1912
Application No. 08/988,181

ON BRIEF

MAILED

MAR 19 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Shinichi Oshima appeals from the final rejection (Paper No. 16) of claims 12 through 43, all of the claims pending in the application.

The record (see page 1 in the main brief, Paper No. 21) indicates that this appeal is related to a parallel appeal in Application No. 09/060,960 (Appeal No. 2002-2175).

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THE INVENTION

The invention relates to a golf ball package which is defined in representative claims 12 and 31 as follows:

12. A package for receiving a golf ball, said package comprising:

a box body;

a cover fitted over said box body; and

a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.

31. A package for receiving a golf ball, said package comprising:

a box body;

a cover fitted over said box body; and

a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

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THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Connell	1,406,541	Feb. 14, 1922
Taylor	4,921,255	May 1, 1990

THE REJECTION

Claims 12 through 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connell in view of Taylor.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 21 and 23) and to the examiner's answer (Paper No. 22) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

Connell, the examiner's primary reference, discloses "a label adapted or suited for containers holding any of different types of articles" (page 1, lines 77 through 79), and more specifically "a label suitable for cartons or boxes in which may be packed any of a variety of styles or shapes of smoking pipes, the label being adapted for designating the characteristics of a particular style of pipe or pipes contained in any given box or

carton" (page 1, lines 11 through 17). Figure 1 shows the label as comprising a label body 10 bearing (1) pictorial representations 11 of various styles of pipes made and marketed by the manufacturer, (2) indicia such as a star 13 within the representation of the particular style of pipe packaged in the carton, (3) a space 14 with a descriptive representation 15, e.g., the word "Poker," and the star indicia 16 of the packaged pipes, (4) a space 17 with the word "Quantity" and the number of pipes, e.g., 100, in the carton, (5) spaces 20 and 21 with a trade number and trade name representative of the physical characteristics of the packaged pipes, (6) a central space 22 with the trade mark 23 of the manufacturer on a background color-coded to denote the price of the packaged pipes, and (7) a space 24 with the name of the manufacturer on a like color-coded background. Connell teaches that this label serves to quickly and accurately convey the identity and characteristics of the articles packaged in the box or carton (see Connell at page 1, lines 8 through 94).

As conceded by the examiner (see page 3 in the answer), Connell does not respond to any of the limitations in independent claims 12 and 31 tying the claimed package to a golf ball.

Taylor discloses golf balls having different dimple patterns which afford different in-flight trajectories, e.g., the low trajectories favored by most amateurs and the high trajectories desired by professionals and accomplished amateurs.

In proposing to combine Connell and Taylor to reject claims 12 and 31 (see pages 3 through 5 in the answer), the examiner submits that

[a]lthough Connell discloses cigar [sic, smoking pipe] information on the box a difference in what is attributed to printed matter does not provide a basis on which patentability may be predicated. . . . Golf balls with different playing characteristics, as disclosed by Taylor, are usually sold in boxes having a cover. It would have been obvious for one skilled in the art to label a box with pictorial illustrations and descriptive text of each ball since such is a conventional technique for informing the golfer of the different golf balls [answer, page 3].

The threshold issue with respect to this rejection is whether Connell is non-analogous art as urged by the appellant (see page 2 in the reply brief). In an obviousness determination under § 103(a), art which is non-analogous is too remote to be treated as prior art. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). There are two criteria for determining whether a reference is analogous art: (1) whether the reference is from the field of the inventor's endeavor,

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regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether it is reasonably pertinent to the particular problem with which the inventor was involved. Id.

The specification in the instant application indicates that the appellant's field of endeavor is labeled packages for golf instruments (see page 1) and that the particular problem facing the appellant was to label such packages so as to allow a golfer to choose an instrument matching his or her skill and ability (see page 3). Even if the Connell reference does not fall within this field of endeavor, it certainly is reasonably pertinent to this problem. Hence, Connell constitutes analogous art which was properly considered by the examiner in evaluating the obviousness of the subject matter recited in the appealed claims.

Next is the issue of the examiner's dismissal of the so-called printed matter limitations in the appealed claims as not providing a basis on which patentability may be predicated. In independent claims 12 and 31, these limitations pertain to the icons and sets of descriptive information relating to performance characteristics of the packaged golf ball.

Differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it is not entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id.

In the present case, a functional relationship clearly exists between the printed matter (the icons and sets of descriptive information relating to performance characteristics of the golf ball) and the substrate (the golf ball package). Thus, the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight in assessing the obviousness of the claimed invention.

As for the teachings of the applied prior art, Connell's disclosure of a label designed to quickly and accurately convey the identity and characteristics of articles packaged in a box or carton would have furnished the artisan with ample suggestion or motivation to apply such a label to a package containing a golf ball of the sort disclosed by Taylor for the same reasons. There is nothing in the disclosures of these references, however, which would suggest providing the label with plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31. In this regard, none of the packaged article characteristics depicted by the Connell label can reasonably be interpreted as a "performance" characteristic.

Thus, the combined teachings of Connell and Taylor do not justify a conclusion that the differences between the subject matter recited in independent claims 12 and 31 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 12 and 31, and

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dependent claims 13 through 30 and 32 through 43, as being obvious over Connell in view of Taylor.

SUMMARY

The decision of the examiner to reject claims 12 through 43 is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)
)

Lawrence J. Staab

LAWRENCE J. STAAB) BOARD OF PATENT
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